

REMARKS

Please note that Applicant's remarks are presented in the order in which the issues were raised in the Office Action for the convenience and reference of the Examiner. In addition, Applicant requests that the Examiner carefully review each of the references discussed below to ensure that Applicant's understanding and discussion of the references is consistent with the Examiner. Further, the following remarks are not intended to be an exhaustive enumeration of the distinctions between any particular reference and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and that reference.

Claims 1-19 were pending in the application. By this response, Applicant has cancelled claims 14-19, amended claims 1, 3, 4, 7, 10 and 12, and added new claims 20-37. Claims 1, 3, 4, 7, 10 and 12 were amended to further clarify the invention as recited therein. Applicant respectfully submits that the amendments to the claims and the addition of the new claims are supported in the specification and entry thereof is respectfully requested.

A. Anticipation Rejection

Pages 2 and 3 of the Office Action rejected claims 1-2, 6-7, 14-15 and 19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,817,139 to Russo. Claim 14 has been cancelled and, as such, Applicant respectfully submits that the anticipation rejection with respect to claims 14, 15 and 19 is moot.

With regard to independent claims 1 and 7, the Office Action cited Figure 3 of the Russo reference as teaching the limitations thereof. The Russo reference teaches a shoulder rest having a curvilinear band 32 and track 26. The curvilinear band 32 comprises a pedestal 34 on a top

portion thereof. A figurine 36 composed of a firm, yet resilient-surface material is attached to pedestal 34. The curvilinear band 32 also has leg portions 40, 42 (numerals added by the Examiner for purposes of discussion). The leg portions 40, 42 are connected to a base 38. The base 38 of curvilinear band 32 includes a pair of co-linear flanges 20 curving under the base. The curvilinear track 26 is attached to a handset handle 24 by suitable adhesive means (e.g., contact cement strip 28). The cradle 10 then slidably engages track 26.

As shown in Figure 3, the curvilinear band 32 is a **fixed member**. The Office Action asserted that the track 26, base 38, leg 40 and leg 42 of the Russo reference correspond to the recited "base portions" of claim 1 and 7. Further, the Office Action asserted that the interior space of the curvilinear band 32 corresponds to the "cut-out portion" recited in claims 1 and 7. Applicant does not agree with the characterization of the Russo reference. However, even under this interpretation of the Russo reference, the Russo reference still does not teach "at least a portion of said base portions [] configured to be selectively positioned closer together or farther away from each other" as recited in independent claim 1. Nor does the Russo reference teach "configuring the base portions so that at least a portion of said base portions can be selectively positioned closer together or farther away from each other" as recited in independent claim 7. As such, Applicant respectfully requests that the anticipation rejection with respect to independent claims 1 and 7 be withdrawn.

Claims 2 and 6 depend from claim 1 and thus incorporate the limitations thereof. As such, Applicant respectfully submits that claims 2 and 6 are distinguishable over the Russo reference for at least the same reasons that claim 1 is distinguishable. As such, Applicant respectfully requests that the anticipation rejection with respect to claims 2 and 6 be withdrawn.

B. Obviousness Rejection

Pages 3 and 4 of the Office Action rejected claims 3-5, 10-12 and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over the Russo reference in view of U.S. Patent No. 6,341,163 to Castle et al. By this response, Applicant cancelled claims 14-19. Thus, the Applicant respectfully submits that the obviousness rejections to claims 16-18 are moot.

With regard to claims 3-4 and 10-12, the Office Action asserted that it would be obvious to modify the curvilinear band 34 in the Russo Reference with the strap 102, 110 or 224 and adhesive or Velcro as taught in the Castle reference. However, even if the Russo reference were modified as suggested by the Office Action, the combination would still lack "at least a portion of said base portions [] configured to be selectively positioned closer together or farther away from each other" as recited in claim 1 and "configuring the base portions so that at least a portion of said base portions can be selectively positioned closer together or farther away from each other" as recited in independent claim 7. As such, Applicant respectfully requests that the obviousness rejection with respect to claims 3-4 and 10-12 be withdrawn.

With regard to claim 5, the Office Action refers to Figures 13a through 13e of the Castle reference. Figure 13b, in particulars, shows a decorative member 400 in the shape of a shark. The Office Action asserted that it would be obvious to modify the pedestal 34 and figurine 36 of the Russo reference with the shark 400 of the Castle reference to satisfy the limitations of claim 5. However, Applicant respectfully submits that even if the Russo reference were so modified, the combinations still lacks teaching of "at least a portion of said base portions are configured to be selectively positioned closer together or farther away from each other" as recited in independent claim 1. As such, Applicant respectfully requests that the obviousness rejection with respect to claim 5 be withdrawn.

Pages 4 through 7 of the Office Action rejected claims 1-2, 6-7, 14-15 and 19 under 35 U.S.C. § 103¹ as being anticipated by U.S. Patent No. 4,961,223 to Sutton (the Sutton '223 reference) in view of U.S. Patent No. 4,759,058 to Sutton (the Sutton '058 reference). As discussed above, applicant has cancelled claims 14-19 so an obviousness rejection with respect to these claims is now moot.

The Sutton '223 reference discloses a shoulder rest having a cradle 10 having a connection 11 having an elongate split tube 12. A holder 13 has a cylindrical rod 14 received within the split tube. A pair of V-shaped clips 17, 18 extends from the rod 14 and is adapted to engage a handset. As stated in the Office Action, the Sutton '223 reference does not disclose use of an adhesive to mount the shoulder rest to a handset.

The Sutton '058 reference teaches a shoulder rest having a cradle 10 connected to a contoured stiff base 15. The base 15 is connected to a connecting member 50 having an extension 52 connected to the base 15 and a U-shaped member 54 on the opposing side. The U-shaped member 54 is the size of a telephone shank. Adhesive strips 57, 57' and 57'' are located on the bottom portion of the U-shaped member 54.

Applicant respectfully traverses this rejection. As shown in Figure 1 of the Sutton '223 reference, clips 17, 18 extend from opposing ends of rod 14. The Sutton '223 reference shows that clips 17, 18 are integrally formed with rod 14 and, thus, cannot be "configured to be selectively positioned closer together or farther away from each other" as recited in independent claim 1. Under this same reasoning, the '223 reference does not teach "configuring the base portions so that at least a portion of said base portions can be selectively positioned closer together or farther away from each other" as recited in independent claim 7. Combining the

¹ Note that the Office Action issued a 102(b) rejection. However, it appears to the Applicant that the Examiner used

Sutton '058 reference with the Sutton '223 reference would not produce the limitation missing in the Sutton '223 reference. As such, Applicant respectfully requests that the obviousness rejection with respect to claims 1 and 7 be withdrawn.

Claims 2 and 6 depend from claim 1 and thus incorporate the limitations thereof. As such, Applicant respectfully submits that claims 2 and 6 are distinguishable over the combination of the Sutton '223 reference and the Sutton '058 reference for at least the same reasons that claim 1 is distinguishable. As such, Applicant respectfully requests that the obviousness rejection with respect to claims 2 and 6 be withdrawn.

Finally, page 7 of the Office Action rejected claims 3-5, 10-12, 16-18 under 35 U.S.C. 103(a) as being unpatentable over the Sutton '223 or the Sutton '058 references in view of the Castle reference. By this response, Applicant cancelled claims 14-19. Thus, the Applicant respectfully submits that the obviousness rejections to claims 16-18 are moot.

With regard to claims 3-4 and 10-12, the Office Action asserted that it would be obvious to modify the clips 17, 18 of the Sutton '223 reference or the connecting member 50 of the Sutton '058 reference to include the strap 102, 110 or 224 and adhesive or Velcro as taught in the Castle reference. However, even if the Sutton '223 reference or Sutton '058 reference were modified as suggested by the Office Action, the combination would still lack "at least a portion of said base portions [] configured to be selectively positioned closer together or farther away from each other" as recited in claim 1 and "configuring the base portions so that at least a portion of said base portions can be selectively positioned closer together or farther away from each other" as recited in independent claim 7. As such, Applicant respectfully requests that the obviousness rejection with respect to claims 3-4 and 10-12 be withdrawn.

a combination of reference in order to assert a prima facie case of obviousness.

With regard to claim 5, the Office Action asserts that it would be obvious to modify the cradle 10 of either the Sutton '223 or the Sutton '058 reference with the shark 400 of the Castle reference to satisfy the limitations of claim 5. However, Applicant respectfully submits that even if the Russo reference were so modified, the combinations still lacks teaching of "at least a portion of said base portions [] configured to be selectively positioned closer together or farther away from each other" as recited in independent claim 1. As such, Applicant respectfully requests that the obviousness rejection with respect to claim 5 be withdrawn.

C. New Claims

Applicant respectfully submits that new claims 20 through 37 are distinguishable over the Russo, Castle, Sutton '223 and/or Sutton '058 references by themselves or in combination.

With regard to new independent claims 23 and 29, none of the references by themselves or in combination teach or suggest a "at least a portion of the first and second base portions are configured to be selectively positioned closer together or farther away from each other" as recited in independent claim 22. In addition, none of the references by themselves or in combination teach or suggest "a second portion comprising a space formed on a bottom portion thereof . . . [and] means for increasing or decreasing the size of the space" as recited in independent claim 28. As such, Applicant respectfully submits that independent claims 22 and 28 are in condition for allowance.

In addition, dependent claims 20, 22, 24 and 34 are further distinguishable over a combination of the Sutton references. Claim 20 depends from claim 1 while claim 22 depends from claim 7. Claim 20 recites "an adhesive material placed on at least a portion of said terminal ends of said base portions." Claim 22 recites "placing an adhesive on at least a portion of said

terminal ends of said base portions." Claim 24 recites "an adhesive material disposed on at least a portion of at least one of the flexible strip, the terminal end of the first base portion or the terminal end of the second base portion." Finally, claim 34 recites "the means for connecting the second portion to a handset comprises an adhesive material disposed on the second portion."

The Office Action asserted that it would have been obvious to modify the Sutton '223 reference with an adhesive as taught by Sutton '058 reference. However, Applicant respectfully submits that modifying the Sutton '223 reference as asserted by the Office Action would destroy the intended function of the headrest of the Sutton '223 reference.

The Sutton '223 reference teaches that its clips (components 17 and 18) have a pair of L-shaped tabs (*e.g.*, component 19) which sit flat on the back of the handset and also engages around the side and slightly around the front of the handset. Col. 3, ll. 17-22. These tabs are tightened as needed by the use of a screw (component 22) in order to secure the shoulder rest to the cellular telephone handset in a manner which also allows the shoulder rest to be readily released from the cellular telephone. The Office Action asserted that it would have been obvious to modify the Sutton '223 reference with an adhesive as taught by Sutton '058 reference. However, Applicant respectfully submits that such a combination as suggested by the Examiner would destroy the intended function of the invention described in the Sutton '223 reference. That is, the Sutton '223 reference is directed to a head rest that is **removable by releasing the pressure** applied by the screw 22 to release the clips 17, 18 from the handset.

In contrast, claims 20, 22, 24 and 34, as further clarified by the present amendment, utilize a fundamentally different concept. Rather than rely on releasable mechanical pressure applied by screws and tabs which surround the handset as taught in the Sutton '223 reference, claims 20, 22, 24 and 34 rely on adhesive to fix the headrest to the handset. One of skill in the

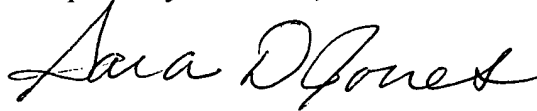
art would not be motivated to replace a removable means, such as screw 22, with a permanent means, such as adhesive, since such modification would destroy the intended function of the Sutton '223 reference, that is, to be able to selectively remove the headrest from the handset. As such, Applicant respectfully submits that claims 20, 22, 24 and 34 are further distinguishable over the cited references and are, thus, in condition for allowance.

CONCLUSION

In view of the foregoing, this application is in condition for allowance and favorable action is respectfully requested. In the event of any question, the Examiner is respectfully requested to initiate a telephone conversation with the undersigned.

Dated this 23rd day of June 2004.

Respectfully submitted,



SARA D. JONES
Attorney for Applicant
Registration No. 47,691
Customer No.: 022913